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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,435	05/10/2005	Jean Paul Nelissen	GIV.P20715	4507

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EXAMINER	
DEES, NIKKI H	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
12/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/534,435	NELISSEN ET AL.	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed October 3, 2008, has been entered. Claims 1-21 are currently pending in the application. The previous 102 rejections of claims 1 and 2 over Oon et al. and Fenne et al. have been withdrawn in view of Applicant's amendments to claims 1 and 2.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenne et al. (GB 661184).

4. Fenne et al. teach polyacetals of the general formula $C_2H_5O[-CH(CH_3)-O]_n-C_2H_5$ wherein the compound may be triacetal (n=3) or higher (col. 1 lines 26-34).

5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a produced the compound above wherein n=6 or higher based on the teachings of Fenne et al. if a larger polyacetal were desired. This would not have required undue experimentation on the part of the artisan, and there would

have been a reasonable expectation that the resulting compound would have possessed the desired structure.

6. Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH2- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers *prima facie* obvious). MPEP § 2144.09 (II). As the compounds of the instant invention differ from the prior art in the presence of the successive addition of the same chemical group, $-CH(CH_3)O-$, the claimed compounds are considered *prima facie* obvious over the prior art.

7. Claims 4-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone (4,280.011) in view of Fenne et al. (GB 661184).

8. DeSimone teaches a method for utilizing an acetaldehyde precursor for a flavoring agent, as well as a flavoring composition and comestibles comprising the flavoring agent in the form of an acetaldehyde precursor (col. 1 lines 12-18; col. 18 lines 31-67).

9. DeSimone is silent as to the specific structure of acetaldehyde precursor as claimed by Applicants.

10. Fenne et al. teach the acetaldehyde precursor as claimed by Applicants wherein n=1 and R_1 and R_2 are both $-CH_2CH_3$. They further provide motivation for making the compound wherein n is 5 to 10, as detailed above.

11. One of ordinary skill in the art at the time the invention was made would have been able to utilize the compounds as taught by Fenne et al. as acetaldehyde precursors for use in the invention of DeSimone. As DeSimone teaches that acetaldehyde precursors are desirable as flavoring agents in foodstuffs and Fenne et al teach acetaldehyde precursors, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have tried the compounds of Fenne et al. in the invention of DeSimone in order to provide flavoring compositions for providing acetaldehyde flavors in foodstuffs as a person of ordinary skill has good reason to pursue known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation, but of ordinary skill and common sense. Further, because the compounds taught by Fenne et al. would function as acetaldehyde precursors as taught for flavoring agents by DeSimone, it would have been obvious to one of ordinary skill in the art to utilize the compounds as flavoring agents.

Response to Arguments

12. Applicant's arguments filed October 3, 2008, have been fully considered but they are not persuasive.

13. Applicant argues that the compounds of instant claims 1-3 are not obvious over Fenne et al. (Remarks, p. 6).

14. In response, it is noted that the claimed compounds are homologs of compounds taught by Fenne et al. Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH2- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers *prima facie* obvious). MPEP § 2144.09 (II).

15. The rejection has been amended to address applicant's amendments to claims 1 and 2.

16. Applicant argues (Remarks, pp. 6-7) that the teachings of Fenne et al. and DeSimone are not specific enough to render the compounds of Fenne et al. obvious to try as aldehyde precursors.

17. In response, it is noted that the compounds of Fenne et al. are homologs of the claimed compounds and, as such, are considered to render the claimed compounds *prima facie* obvious. Further, the compounds of Fennel et al. are known to be aldehyde precursors. DeSimone teaches aldehyde precursors as flavoring compounds. "Obviousness does not require absolute predictability of success." *Id.* at 903, 7 USPQ2d at 1681. As the claimed compounds wherein R_1 and R_2 are both $-CH_2CH_3$ are

considered to be obvious over the prior art, and the class of claimed compounds are known to be used as flavorants, it is considered obvious to utilize the claimed compounds as flavorants.

18. Further, the substituents claimed for R_1 and R_2 are claimed in the alternative. Therefore, the prior art which teaches R_1 and R_2 are both $-CH_2CH_3$ is considered to render the instant claims obvious.

19. Applicant argues (Remarks, p. 7) that DeSimone "merely provides" flavor compounds, without the advantages of the instant invention.

20. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., improved stability and/or release rates of the compounds) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

/Nikki H. Dees/
Examiner
Art Unit 1794